

#9

Practitioner's Docket No. 1798-2

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: MASSON, Marcos V.; HENRY, Mark H.

Application No.: 09 / 916819

Group No: 3625

Filed: Jul. 30, 2001

Examiner: Smith, J.A.

For: CIRCUMFERENTIAL

Date of mailing "Notice of Allowance and Base

RETRACTOR

Issue Fee Due" Jul. 3, 2002

APPARATUS

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"Petitions to have an application withdrawn after payment of the issue fee should be directed to the Office of Petitions (see M.P.E.P. § 1002.02(b))" M.P.E.P., 8th Edition.

NOTE: Any petition to withdraw an application from issue after payment of the issue fee should be either submitted by facsimile or hand-carried to the Office of Petitions, M.P.E.P., 8th Edition.

**PETITION FOR WITHDRAWAL FROM ISSUE AND ABANDONMENT
—ISSUE FEE PAID—TO PERMIT CONSIDERATION OF
AN INFORMATION DISCLOSURE STATEMENT UNDER § 1.97
IN A CONTINUING APPLICATION (37 C.F.R. § 1.313(c)(3))**

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

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John S. Egbert

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* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Petition for Withdrawal From Issue and Abandonment—Issue Fee Paid—To Permit Consideration of an Information Disclosure Statement Under § 1.97 in a Continuing Application)

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NOTE: "Paragraph (a) of § 1.56 states that the duty to disclose information exists until the application becomes abandoned. The duty to disclose information, however, does not end when an application becomes allowed but extends until a patent is granted on that application. The rules provide for information being considered after a notice of allowance is mailed and before the issue fee is paid (§ 1.97(d)) and for an application to be withdrawn from issue after the issue fee has been paid. An application may be withdrawn from issue because one or more claims are unpatentable . . . or an application may be withdrawn from issue and abandoned so that information may be considered in a continuing application before a patent issues. . . ." Notice of January 9, 1992, 1135 O.G. 13-25, at 16.

NOTE: If an application is withdrawn from issue . . . , an information disclosure statement can be submitted in the continuing application under § 1.97(b) without a certification. A continuing application is treated like any other application with regard to the times set forth in § 1.97(b). Thus, for example, an information disclosure statement could be filed without a fee or certification in a continuing application within three months of the filing date of the continuing application. Notice of January 9, 1992, 1135 O.G. 13-25, at 21.

NOTE: "It would not be proper to make final a first Office action in the continuing application if the information submitted is used in a new ground of rejection." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

NOTE: If the petition is made [§ 1.313(c)(1)], that one or more claims are unpatentable, then the Notice of April 20, 1992 (1138 O.G. 37-41) states:

"This statement that one or more claims are unpatentable over the information must be unequivocal. A statement that a serious question as to patentability of a claim has been raised, for example, would not be acceptable to withdraw an application from issue under 37 C.F.R. § 1.313(c)(1)."

NOTE: "The Office will consider [the filing of a petition to permit consideration of an information disclosure statement under § 1.97 in a continuing application] . . . as sufficient grounds to waive the requirement that [a continuing] application . . . be filed before payment of the issue fee." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

PETITION

1. Applicant hereby petitions for the withdrawal of this application from issue.

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PATENT ISSUE FEE

OCT 24 2002

2. The issue fee for this case was paid on Aug. 5, 2002

OFFICE OF PETITIONS

(complete the following, if known)

This application is scheduled to

- ☐ issue on _____
☐ as patent _____

REASON(S) FOR WITHDRAWAL REQUEST

3. The reason for withdrawal from issue and abandonment of this application is for consideration of an information disclosure statement in a continuing application. 37 C.F.R. § 1.313(c)(3).

EXPRESS ABANDONMENT

4. ☒ Accompanying this petition is an express abandonment of this application to be effective on the grant of this petition and when the continuing application is granted a filing date so as to make this application copending with the continuing application, and so as to avoid publication of the present application.

(Petition for Withdrawal From Issue and Abandonment—Issue Fee Paid—To Permit Consideration of an Information Disclosure Statement Under § 1.97 in a Continuing Application)

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FILING OF CONTINUING APPLICATION

5. The continuing application claiming priority under 35 U.S.C. § 120 from this application

☒ was filed on Sep. 18, 2002

☐ is being filed on the same date as this petition. (Sent to Box Patent Applications on same day, Express Mail)

☐ These papers accompany this petition.

6. PETITION FEES (37 C.F.R. § 1.17(f))

The petition fee set forth in § 1.17(h), required by 37 C.F.R. § 1.313(a) is paid as follows:

☐ Attached is a ☐ check ☐ money order in the amount of \$ _____

☒ Authorization is hereby made to charge the amount of \$ 130

☐ to Deposit Account No. 08-0879

☒ to Credit card as shown on the attached credit card information authorization form PTO-2038.

WARNING: Credit card information should not be included on this form as it may become public.

☒ Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

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SIGNATURE OF PRACTITIONER

John S. Egbert

(type or print name of practitioner)

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